UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,752	07/23/2003	Steven Weinstein	TVW/APP23USC1	8134

59906 7590 08/22/2007

SYNNESVEDT & LECHNER, LLP
TVWORKS, LLC
1101 MARKET STREET
SUITE 2600
PHILADELPHIA, PA 19107

EXAMINER	
STOKELY-COLLINS, JASMINE N	
ART UNIT	**PAPER NUMBER**
2609	

MAIL DATE	DELIVERY MODE
08/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/625,752	WEINSTEIN ET AL.	
	Examiner	Art Unit	
	Jasmine Stokely-Collins	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-20 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 7/23/2003 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 7/23/03, 9/22/03.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because the numbering of figure 1 is not consistent with the specification. In the specification, the display controller is numbered 140, however it is numbered 14D in the drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

1. Claims 17-19 are objected to because of the following informalities:

Claim 17, limitation "personalized indicia" should be changed to --said received personalized indicia--.

Claim 18, limitation "the personalized indicia" should be changed to --said received personalized indicia--.

Claim 19, limitation "the personalized indicia" should be changed to --said received personalized indicia--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 6 recites the limitation "said internet access device" in line 2. There is insufficient antecedent basis for this limitation in the claim. Claim appears to reference "network access device" of claim 5.

4. Claim 13 recites the limitation "said first image panel" in line 2. There is insufficient antecedent basis for this limitation in the claim.

The examiner will consider the "said internet access device" of claim 6 to refer to the "network access device" of claim 5.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims1-3, 5-7, and 9-10 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shoff et al (US 2005/0015815 A1).

Regarding claim 1, Shoff teaches an information system, comprising: a controller, for generating an image representative signal adapted for

use by a display device (page 2 section 0030-31, Figure 2 element 26, Figure 4 element 68);

a broadcast interface, for applying broadcast information to a controller (page 2 section 0030-31, Figure 2 elements 22 and 32); and

an interactive information interface, for applying interactive information to said controller (Figure 2 element 26, Figure 4 element 68);

said controller including said broadcast information (page 2 section 0015), said interactive information (page 2 section 0018) and a user selectable element (icon) in said image representative signal such that corresponding presented imagery includes

an interactive portion, a broadcast portion and a user selectable element (page 2 section 0017).

Regarding claim 2, Shoff further discloses said user selectable element comprises a hyperlink having associated
with it an object;
said interactive information interface, in response to a selection of said hyperlink (referred to as icon 204), includes said object associated with said hyperlink within said interactive information (page 5 section 0064).

Regarding claim 3, Shoff further teaches an input device for selecting said user selectable element, said input element comprising at least one of a keypad, a pointing device and a graphical user interface (page 5 section 0064).

Regarding claim 5, Shoff further discloses said interactive information interface comprises a network access device (page 4 section 0054).

Regarding claim 6, Shoff further discloses said internet access device includes a web modem (page 4 section 0054).

Regarding claim 7, Shoff further teaches said interactive portion of said imagery comprises objects retrieved from a network and displayed in a first image panel; and

said broadcast portion of said imagery comprises broadcast video imagery displayed in a second image panel (page 2 section 0019, page 5 section 0055).

Regarding claim 9, Shoff further teaches said user selectable element includes a control button (soft button 217) for selecting a preference, said preference being used to determine how said broadcast information is presented in relationship to said interactive information (page 6 section 0073).

Regarding claim 10, Shoff further discloses said first image panel is used to display web content (page 2 section 0019 states that supplemental content is displayed concurrently with video content, and page 3 section 0041 teaches web content being supplemental content).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff et al (US 2005/0015815 A1) in view of Nakano et al (US 5,745,109).

Regarding claim 8, Shoff teaches the system of claim 7 where multiple panels are simultaneously displayed. Shoff does not disclose said first panel is at least partially transparent and overlaps said second panel.

Nakano teaches a first panel is at least partially transparent and overlaps a second panel (Figure 6A).

It would have been obvious to one ordinarily skilled in the art, at the time the invention was made, to combine the teachings of Shoff and Nakano in order to see the broadcast image through the interactive window (as stated by Nakano column 5 lines 58-60).

9. Claims 4, 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff et al (US 2005/0015815 A1) in view of Merriman et al (US 5,948,061).

Regarding claim 4, Shoff teaches the method of claim 1.

Shoff does not disclose data memory for storing a user preference.

Merriman teaches data memory for storing a user preference (column 5 lines 50-60, where the cookie represents the user preference). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teachings of Shoff and Merriman for the benefit of creating a user profile.

Regarding claim 11, Shoff in view of Merriman teach the methods of claims 1 and 4.

Merriman further discloses said user preference (cookie) stored in said data memory (database) is accessible to at least a networked server to which the preference relates (column 5 lines 50-60).

Regarding claim 12, Shoff teaches the system of claim1.
Shoff does not teach said interactive information interface retrieving information from a network in response to the reception of broadcast information conforming to a user preference.
Merriman teaches said interactive information interface retrieving information (advertisement) from a network in response to the reception of broadcast information conforming to a user preference (column 6 lines 56-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Shoff and Merriman for the benefit of retrieving information that is tailored to each user.

Regarding claim 13, as analyzed with respect to claims 1 and 12, Shoff further teaches displaying all supplemental information (page 2 section 0017). Shoff further discloses a using image panels to display supplemental I formation and programs (figure 8c).

Regarding claim 14, as analyzed with respect to claims 1 and 12, Merriman further teaches a database for storing user preferences (the types of ads he prefers via element "ads clicked on", figure 3A).

Regarding claim 15, as analyzed with respect to claims 1 and 12, "data memory for storing a user preference, said user preference being stored in said memory in response to user interaction via said user selectable element" is further met by Shoff in view of Merriman because Merriman's user preference is collected and stored in the memory (buffer) and later collected by the central office/head end for storing based on the user's selection (by clicking on) of different advertisements (column 2 lines 8-15, column 5 lines 50-65)

Regarding claim 16, Shoff teaches a method of displaying information comprising:
initializing a display system (page 2 section 0019);
receiving selected web content (page 2 section 0017-19);
receiving broadcast content (page 2 section 0019);
formatting received web content and received broadcast content into video information (figure 8c, page 7 section 0080); and
displaying video information to simultaneously produce interactive information having a user selectable element (figure 8c element 237, page 7 section 0080) and a television broadcast (figure 8c).
Shoff does not teach receiving personalized indicia; and
formatting received personalized indicia into video information;
Merriman teaches sending personalized indicia in the form of a web browser cookie (column 5 lines 18-28) in which the ad server (advertisers) use the collected information

from the cookie for future delivering of targeted ads to corresponding user (column 5 line 65 – column 6 line 60). It would be obvious to one of ordinary skill in the art, at the time the invention was made, to combine the teachings of Merriman and Shoff to enable targeted advertising and to collect information about users.

Regarding claim 17, Shoff (page 2 section 0018) in view of Merriman further discloses "including identifying personalized indicia within at least one of the displayed video information and an out-of-band portion of a television signal. Note, the combination of Shoff in view of Merriman would result that Merriman's personalized indicia would be displayed in Shoff's GUI interface and carried within the out-of-band portion of the TV signal.

Regarding claim 18, Shoff and Merriman teach the method of claims 16 and 17 as analyzed above by displaying the personalized information, i.e. ads/commercials, based on the personalized indicia (cookie with personal preference).

Regarding claim 19, see analysis of claim 16.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff et al (US 2005/0015815 A1) in view of Merriman et al (US 5,948,061), and further in view of Patterson (US 5,923,379).

Regarding claim 20, Shoff in view of Merriman discloses the system of claims 1, 12, and 15. Shoff and Merriman do not teach retrieving preferences and formatting the received selected web content and received broadcast content based on those preferences. Patterson teaches a television and Internet content display interface that includes retrieving preferences and formatting the received selected web content and received broadcast content based on those preferences (abstract, column 6 lines 9-13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Patterson with the system of Shoff in view of Merriman for the benefit of further personalizing the system to a user.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Willbanks (US 5,703,995) teaches the use of personalized indicia.

Rosenberg et al (US 6,073,241) teaches the use of internet cookies.

Hidary et al (US 5,774,664) teaches an interactive and personalized video programming system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasmine Stokely-Collins whose telephone number is 571-270-3459. The examiner can normally be reached on M-Th 8-6:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hai Tran can be reached on 571-272-7305. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jasmine Stokely-Collins
July 23, 2007

SCOTT E. BELIVEAU
PRIMARY PATENT EXAMINER